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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------|------------------|
| 09/880,732 | 06/12/2001 | Gary Bee | 089498-0402 | 4949 |
| 20583 | 7590 | 02/09/2007 | | |
| JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017 | | | EXAMINER JOHANNSEN, DIANA B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1634 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 02/09/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|---------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 09/880,732 | Applicant(s) BEE ET AL. | |
| | Examiner Diana B. Johannsen | Art Unit 1634 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9 and 59-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9 and 59-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL ACTION

1. This action is responsive to the Response filed November 30, 2006. Applicants' arguments have been thoroughly considered but are not persuasive for the reasons set forth below. Claims 1-6, 9, and 59-71 remain pending and are under consideration herein. **This action is final.**
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112, first paragraph

3. Claims 1-6, 9, and 59-71 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for the reasons set forth in the Office action of June 30, 2006 and reiterated below. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

In the Amendment filed April 5, 2006, Applicants amended claim 1 so as to include the limitation "using white light, with the proviso that the white light is not evanescent wave light." The originally filed specification does not provide basis for this limitation. It is noted that the specification refers to methods that "use illumination with non-evanescent wave light" (see page 11, lines 8-9), and that the specification discloses particles that exhibit certain properties when illuminated with white light (see page 5, lines 22-26, and page 12, lines 21-23). However, the specification does not disclose methods "using white light, with the proviso that the white light is not evanescent wave

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light.” It is noted that Applicants’ response refers only to page 5, line 24 as providing basis for the amendment; however, this section of the specification describes properties of particles when illuminated by white light – Applicants’ have not identified any basis for methods employing the type of light now required by the claims. Accordingly, Applicants’ amendment introduces new matter.

The response of November 30, 2006 traverses the rejection on the following grounds. The response asserts that the examiner is requiring “*ipsis verbis* support in the specification for claim 1,” and argues that such a description is not required, citing *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 1999). The response urges that the “specification as filed would allow one of ordinary skill in the art to recognize or visualize the presently claimed invention; albeit not in *ipsis verbis* terms.” The response states that the specification “provides ample support for illuminating the particles using white light when it states that ‘different colors of scattered light [can be generated upon] illumination of polychromatic light, such as white light,’” and that the specification “also provides support for the concept that the illuminating light, which may certainly include white light, can be non-evanescent when it states that ‘the methods of this invention [may] use illumination with non-evanescent wave light,....’”. The response further argues that “there is no explicit teaching or even suggestion that, when white light is used as the illuminating light, the wave light must not be evanescent,” and that “one of skill in the art would easily recognize and be able to visualize that the non-evanescent light that is used to illuminate the particles may

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also be white light." Applicants conclude that "the specification taken as a whole would allow one of skill in the art to visualize the presently claimed invention."

These arguments have been thoroughly considered but are not persuasive for the following reasons. First, it is noted that the examiner agrees that *ipsis verbis* support is not required in order to fulfill the written description requirement of 35 U.S.C. 112, first paragraph. However, this was not in fact the standard applied or employed by the examiner in concluding that applicants' amendments constituted new matter. Rather, the content of the original application as a whole was reviewed to determine whether the application expressly, implicitly, and/or inherently provided support for applicants' amendments (see *MPEP* 2163.05). As discussed in *MPEP* 2163.05 II, the "introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written description requirement of 35 U.S.C. 112, first paragraph." As was acknowledged in the rejection, the originally filed specification clearly discloses illumination with white light, as well as illumination with "non-evanescent wave light." More specifically, with regard to applicants' citation of paragraph 56, the examiner concurs that white light is disclosed as an example of a type of "polychromatic light" that may be employed for illumination; the examiner also agrees that paragraph 46 teaches that "the methods of this invention use illumination with non-evanescent wave light." However, neither these particular teachings, nor the specification when considered as a whole, provide support for applicants' amendments to the claims, which attempt to further limit white light to white light that "is not evanescent wave light." While the

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specification does disclose both white light and non-evanescent wave light, there is no disclosure (be it express, implicit, or inherent) of a particular type or subcategory of white light that is "not evanescent wave light," as is now required by applicants' claims. This amendment thus violates the written description requirement by introducing a further limitation not supported in the as-filed disclosure. Accordingly, applicants' arguments are not persuasive, and this rejection is maintained.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

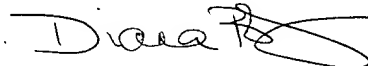
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 571/272-0744. The examiner can normally be reached on Monday and Thursday, 7:30 am-4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached at 571/272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Diana B. Johannsen
Primary Examiner
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